

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application. Claims 1-2 and 4-14 are currently pending in this application. No claims have been amended. Accordingly, no new matter has been added.

In view of the remarks herein, Applicants respectfully request that the Examiner withdraw all outstanding rejections and allow the currently pending claims.

Double Patenting Issues

The Examiner maintains the rejection of claims 6, 9 and 10 on the ground of nonstatutory obviousness-type double patenting over claims 1 and 2 of U.S. 6,802,993 to Momoda et al. (hereinafter Momoda '993). Applicants respectfully traverse.

Enclosed herewith is a Terminal Disclaimer, which disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of U.S. 6,802,993.

Accordingly, the double patenting rejection has been obviated by the Terminal Disclaimer. Reconsideration and withdrawal of this rejection are thus respectfully requested.

Issues Under 35 U.S.C. 102/103

EP '038

Claims 1, 4-7 and 9-10 stand rejected under 35 U.S.C. §102(b) as anticipated by, or in the alternative, under 35 U.S.C. 103(a) as obvious over EP 1,130,038 (hereinafter Momoda '038). Applicants respectfully traverse.

The Examiner asserts that Momoda '038 discloses a curable composition comprising (A) a polymerizable monomer, (B) a polyfunctional monomer, (C) a difunctional polymerizable monomer and (D) a photochromic compound. The Examiner further asserts that the cured product of the compositions of this reference would inherently have tensile strengths of 20kgf, or "for those who do not have said strength, have tensile strengths close enough to said strength that it would have been obvious for one of ordinary skill in the art to optimize the ratio of monomers to achieve a product with higher tensile strength."

Moreover, in response to Applicants' arguments of June 5, 2008, the Examiner asserts that, "[g]iven that the reference teaches a polymerization curable composition as presently claimed, it is unclear how the cured product of Momoda '038 would not inherently meet the tensile strength limitation" (page 10, par. no. 47).

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of anticipation. For anticipation under 35 U.S.C. §102, the reference must teach each and every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993). To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present". *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999). The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *Id.*

The present invention is directed, *inter alia*, to a polymerization curable composition and photochromic lens substrate comprising a cured product of the polymerization curable

composition, wherein the cured product has a tensile strength of 20kgf or more. Momoda '083 fails to explicitly or implicitly teach a composition or lens substrate as presently claimed.

Applicants respectfully submit that the Examiner's inherency assertion with regard to the tensile strength of the composition of Momoda '083 is incorrect. The Examiner's attention is directed to the Declaration Under 37 C.F.R. 1.132 enclosed herewith. Applicants have reproduced Examples 1-7, 10-19, 23-25, 27-28, 32, 34-37, 45, 47, 50 and 57 of Momoda '038, so as to determine the tensile strength of the curable compositions disclosed by this reference.

Applicants note that Examples 8, 9, 20, 21, 22, 26, 29, 30, 31, 33, 38-44, 46, 48, 49, 51-56 and 58 of Momoda '038 have not been reproduced, as the curable compositions used in these Examples are similar to the curable compositions used in other Examples (which have been reproduced). The table below identifies the equivalencies between the Examples:

Example	Equivalency
8	Composition similar to the composition of Example 4
9	Composition similar to the composition of Example 15
20	Composition similar to the composition of Example 19
21	Composition similar to the composition of Example 23
22	Composition similar to the composition of Example 23
26	Composition similar to the composition of Example 25
29	Composition similar to the composition of Example 28
30	Composition similar to the composition of Example 28
31	Composition similar to the composition of Example 28
33	Composition similar to the composition of Example 32
38	Composition similar to the composition of Example 37
39	Composition similar to the composition of Example 37
40	Composition similar to the composition of Example 37
41	Composition similar to the composition of Example 37
42	Composition similar to the composition of Example 37
43	Composition similar to the composition of Example 37
44	Composition similar to the composition of Example 37
46	Composition similar to the composition of Example 45

Example	Equivalency
48	Composition similar to the composition of Example 47
49	Composition similar to the composition of Example 47
51	Composition similar to the composition of Example 50
52	Composition similar to the composition of Example 50
53	Composition similar to the composition of Example 50
54	Composition similar to the composition of Example 50
55	Composition similar to the composition of Example 50
56	Composition similar to the composition of Example 50
58	Composition similar to the composition of Example 57

Applicants further note that it was impossible to exactly reproduce Examples 20 and 41 of Momoda '083 due to unclear terms, such as "TMPT/GG/34 20" and "TMPT 20 57."

The results of Applicants' experiments, shown at page 2 of the enclosed Declaration, evidence that **none** of the compositions disclosed by Momoda '038 exhibit a tensile strength of 20kgf or more (emphasis added). As such, Applicants submit that Momoda '038 fails to explicitly or implicitly teach or suggest each and every limitation of the present invention.

Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

EP '038 in view of secondary references

Claims 1-2, 4, 6, 8, 11 and 13 stand rejected under 35 U.S.C. 103(a) as obvious over Momoda '038 in view of Imura et al. (U.S. 5,556,931) (hereinafter Imura '931). Additionally, claims 1, 4, 12 and 14 stand rejected as obvious over Momoda '038 in view of Geffcken et al. (U.S. 3,713,869) (hereinafter Geffcken '869). Applicants respectfully traverse.

The Examiner acknowledges that Momoda '038 is silent with regard to higher (m+n) values in the bifunctional polymerizable monomer (II). The Examiner further acknowledges that Momoda '038 is silent with regard to the use of a buffer layer interposed between the substrate

and the hard coating layer. The Examiner relies on the teachings of Imura '931 and Geffcken '869 to overcome these deficiencies.

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Additionally, there must be a reason why one of ordinary skill in the art would modify the reference or combine reference teachings to obtain the invention. A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l Co. v Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). There must be a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. *Id.* The Supreme Court of the United States has recently held that the "teaching, suggestion, motivation test" is a valid test for obviousness, albeit one which cannot be too rigidly applied. *Id.* Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rationale underpinning to support the legal conclusion of obviousness. *Id.*

As noted above, Momoda '038 fails to explicitly or implicitly teach or suggest a photochromic lens substrate comprising a cured product of a polymerization curable composition, wherein the cured product has a tensile strength of 20kgf or more. The secondary references cited by the Examiner fail to cure this deficiency.

Imura '931 is directed to a polymerizable composition comprising at least two di(meth)acrylate compounds of the specific general formula (I), suitable as a transparent resin.

Geffcken '869 discloses a method of applying hard inorganic layers to plastics. However, both Imura '931 and Geffcken '869 fail to teach or suggest any components which could be used to provide a cured product having a tensile strength of 20 kgf or more. The disclosure of soft and hard monomers in Imura '931 does not provide any guidance for a person skilled in the art to arrive at the present invention. Thus, both references fail to teach or suggest a polymerizable curable composition or photochromic lens substrate as presently claimed.

Evidently, the cited references, alone or in combination, fail to teach or suggest every limitation of the instant invention. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Conclusion


All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and objections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Vanessa Perez-Ramos, Reg. No. 61,158 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: **FEB 20 2009**

Respectfully submitted,

By 
Marc S. Weiner
Registration No.: 32,181
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant

Enclosure: Declaration Under 37 C.F.R. 1.132

Terminal Disclaimer